

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 16

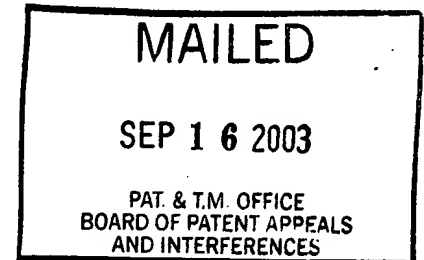
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREAS WINTER, MARTIN ANTBERG,
BERND BACHMANN, VOLKER DOLLE, FRANK KUBER,
JURGEN ROHRMANN and WALTER SPALECK

Appeal No. 2002-0464
Application No. 09/488,037

ON BRIEF



Before SCHAFFER, MEDLEY, and NAGUMO, Administrative Patent Judges.

SCHAFFER, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-3¹ of Application 09/488,037, a reissue of U.S. Patent 5,693,836. The examiner rejected the claims on the basis of interference estoppel. We have jurisdiction pursuant to 35 U.S.C. § 134. We reverse the rejection.

The subject matter of the invention relates to certain cyclopentadienyl-type metallocene compounds said to be useful as polyolefin catalysts. The exact subject matter claimed is not relevant to our decision.

The rejected claims are said to be directed to a subgenus of the subject matter involved in Interference 104,447 between U.S. Patent 5,693,836 (Winter) and Application 08/642,491 (Karl). It is unchallenged on the record that applicant's currently claimed subject matter is not recited specifically in the count, nor is it claimed or

¹In the section of the brief titled "Grouping of the Claims" (Paper 12, p. 5), applicants identify two groups designated I-II. The groups include claims 1-2 and 3, respectively. Applicant argues that the groups do not stand or fall together because of varying degrees of specificity in the claims. Applicants then direct separate arguments to each group. Paper 12, pp. 6-11. Review of the prosecution history shows that applicants did not previously assert the separate patentability of any of the claims. Section 1.111(b) of 37 CFR provides in relevant part with respect to replies to rejections (emphasis added):

- (b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.

Applicants could have and should have raised these points of distinction before the examiner when the estoppel rejection was first made. Waiting until appeal to raise arguments which could have been earlier raised is inefficient and unnecessarily raises costs for both the Office and applicants. Absent a satisfactory explanation as to why the arguments could not have been raised when the rejection was first made by the examiner, we decline to exercise our discretion to consider the arguments at this time. Dependent Claims 2-3 stand or fall with independent Claim 1 as they did during the prosecution before the examiner.

disclosed in the Karl application. A Final Judgment was entered in favor of Karl, the senior party. Interference 104,447, Paper 12. Judgment was issued after a conference call in which "it became apparent that Winter did not urge a basis upon which it might prevail." Interference 104,447, Paper 12, p. 3. During the conference call Winter indicated that it would file a reissue of the Winter patent narrowing the claims to subject matter patentably distinct from the subject matter of the count. Interference 104,447, Paper 12, p. 2. The entry of final judgment was "without prejudice to Winter filing a reissue application and to obtaining a reissue application with claims which are patentably distinct from the count." Interference 104,447, Paper 12, p. 3.

It is the examiner's view that applicants are estopped from claiming the current subject matter since they did not file a preliminary motion under 37 CFR § 1.633(c)(1). Paper 13, p. 3. Section 1.633(c)(1) provides:

A party may file the following preliminary motions:

* * * * *

(c) A motion to redefine the interfering subject matter by (1) adding or substituting a count

The examiner appears to be of the opinion that applicants could have filed a preliminary motion in the interference to substitute a narrower count directed to common subject matter claimed by the parties.

The doctrine of interference estoppel is directed to finality of an interference, at least with respect to all issues which might have been presented in the interference. Interference estoppel must be decided on the facts of each case. In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 643 (Fed. Cir. 1986).

The record of Interference 104,447 shows that the interference was terminated by Final Judgment prior to briefing of any preliminary motions. In issuing the final Judgment, the panel specifically ordered that "entry of this FINAL JUDGMENT is

without prejudice to Winter filing an application to reissue the Winter patent involved in the interference to seek to obtain claims which are patentably distinct from Count 1."

Interference 104,447, Paper 12, p. 3. The Final Judgment also noted that

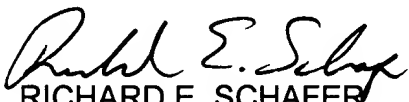
Apart from the interference, Winter may file an application to reissue the Winter patent involved in the interference. If the claims sought to be obtained in the reissue application are directed to an invention which is patentably distinct from the count, a reissue patent containing those claims may be issued.

Interference 104,447, Paper 12, p. 2. Thus, under the particular circumstances of this case, interference estoppel does not operate to prohibit applicant's from seeking claims to subject matter patentably distinct from the count of Interference 104,447.


The only remaining consideration is whether the subject matter of applicants' Claims 1-3 is patentably distinct from the subject matter of the count. The examiner never addresses the issue even though applicants argue that the claims are directed to a patentably distinct subgenus of the count. E.g., Paper 12, p. 7. At best, the examiner appears to have assumed that the subgenus is anticipated by or obvious over the genus. This conclusion is not compelled by law or logic — rather, the examiner must point to facts in the record, and explain how those facts support the conclusion. The burden of proof to show unpatentability is on the examiner. In re Glaug, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152 (Fed. Cir. 2002); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). On the record of this appeal, the examiner has not met his burden to demonstrate that the subject matter of Claims 1-3 is patentably indistinct from the subject matter of the counts.

The decision of the examiner is reversed.

REVERSED


RICHARD E. SCHAFER
Administrative Patent Judge


SALLY C. MEDLEY
Administrative Patent Judge


MARK NAGUMO
Administrative Patent Judge

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